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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/771,227  
Filing Date: January 26, 2001  
Appellant(s): VENEGAS, FRANK

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JOHN POSA  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/22/2009 appealing from the Office action mailed 11/12/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,609,183	ULMER	10-1986
4,236,697	SAVINO	12-1980
5,201,426	CRUWELL, JR.	4-1993

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

Claims 1-3, 8-11, 13-14, 21-23, and 27-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Ulmer (US 4609183) in view of Savino (US 4236697). Regarding claims 1-3, 21, 23, 27-28, Ulmer illustrates in Figures 2-3 and discloses throughout the specification a cart corral system comprising:

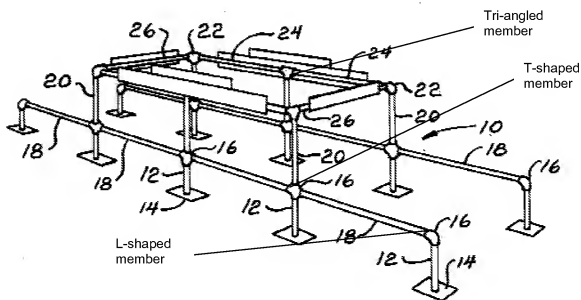
- A first set of at least two spaced apart vertical rails (RFL and LFL);
- A base support (BF) supporting said first set of vertical rails in an upright position; said base support extending between said first set of vertical rails;

- At least two spaced apart horizontal rails (LFT, LRT, RFT, RRT) removably engaged with said vertical rails and positioned above said base support (BF);
- A second set of at least two spaced apart vertical rails (LRL, RRL) opposite of said first set of vertical rails and removably engaged with said horizontal rails;
- Each of said vertical and horizontal rails having an outer diameter and exterior profile (which is inherent to every pipe-shaped object with a thickness);
- A second base support (BR) supporting said second set of vertical rails in an upright position; said second base support extending between said second set of vertical rails;
- Removable and replaceable polymerized sheathing surrounding each of said vertical rails having an interior and exterior diameter, the interior diameter equal to or greater than the outer diameter of said vertical rails and extending the length of said vertical rails;
- Removable and replaceable polymerized sheathing surrounding each of said horizontal rails having an interior and exterior diameter, the interior diameter equal to or greater than the outer diameter of each of said horizontal rails and extending the length of said horizontal rails (The examiner notes that Ulmer's specification lines 1-20 of column 3 states the use of a colored plastic coating surrounding the galvanized steel portions

of the cart corral. A plastic coating certainly satisfies the limitation of a polymerized sheathing);

However, the reference does not disclose separable means for attaching the horizontal rails to the vertical rails comprising a T-shaped member formed of polymerized sheathing and having a hollow interior; wherein each leg of said T-shaped member has an interior profile identical to the exterior profile of said horizontal rails and said vertical rails; said interior profile having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said horizontal rails and said vertical rails. The reference also does not disclose means for separably attaching said horizontal rails to said vertical rails comprising an L-shaped member formed of polymerized sheathing and having a hollow interior; wherein each leg of said L-shaped member has an interior profile identical to the exterior profile of said horizontal rails and said vertical rails; said interior profile having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said horizontal rails and said vertical rails. The reference merely teaches the connection between members as being a loop and fasten connection that can be seen in Figures 2 and 3. It would have been obvious to one having ordinary skill in the art at the time of invention to modify the connection system of the members with that of Savino (see items 16 in Figure 1). Savino discloses in Column 2, lines 3-8 the coupling elements being used because they are threadable and easy to assemble and disassemble. Therefore it would have been obvious to one having ordinary skill in the art to modify the cart corral connections of Ulmer with those of Savino in order to easily and quickly replace

members or poles that have been damaged by motor vehicles within the parking lot the assembly resides in (see column 1 of Ulmer). Furthermore, the examiner notes that both references disclose a maintenance-free corral system for storing shopping carts, therefore are considered analogous art.



Regarding claims 8 and 22, Ulmer illustrates in Figures 2 and 3 comprising a fourth horizontal rail removably engaged with and extending between one of said sets of vertical rails at an angle to said at least two horizontal rails; said fourth horizontal rail positioned above one of said first and second base supports and having an outer diameter; a removable and replaceable polymerized sheathing surrounding said fourth horizontal rail having an interior diameter equal to or greater than the outer diameter of said horizontal rail and extending the length of said horizontal rail. The examiner notes

that any one of LFT, LRT, RFT, or RRT of Ulmer can be considered the fourth horizontal rail since they all extend between the vertical rails at an angle (0 or 90 degrees depending on reference point) and above the base supports.

Regarding claim 9, it is described above what Ulmer in view of Savino teaches. Ulmer further discloses separable means for attaching additional vertical rails to said first and said second base supports comprising a base support extending from said first and second base supports (BTL and BTR).

Regarding claim 10, Ulmer in view of Savino teaches separable means for attaching the horizontal rails to the vertical rails comprising a T-shaped member formed of polymerized sheathing and having a hollow interior; wherein each leg of said T-shaped member has an interior profile identical to the exterior profile of said horizontal rails and said vertical rails; said interior profile having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said horizontal rails and said vertical rails (See above Figure). Savino fails to disclose a specific material in which the member is made from; however Ulmer discloses all parts of the cart corral being made of steel covered with a colored plastic sheathing.

Regarding claim 11, Ulmer in view of Savino teaches means for separably attaching said horizontal rails to said vertical rails comprising an L-shaped member formed of polymerized sheathing and having a hollow interior; wherein each leg of said L-shaped



member has an interior profile identical to the exterior profile of said horizontal rails and said vertical rails; said interior profile having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said horizontal rails and said vertical rails. (See above Figure). Savino fails to disclose a specific material in which the member is made from; however Ulmer discloses all parts of the cart corral being made of steel covered with a colored plastic sheathing.

Regarding claims 13-14, 29-31, Ulmer in view of Savino teaches means for attaching additional horizontal and vertical rails (16 of Savino) to said first and said second set of vertical rails comprising a quad-angled (or multi-angled) member (T-shaped member as shown in the above Figure) formed of polymerized sheathing (see above rationale) and having a hollow interior; wherein each leg of said quad-angled member extends simultaneously in planes to support said additional horizontal rail and vertical rails to said first and said second set of vertical rails; said interior having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said first and said second set of vertical rails. The examiner further notes that Savino illustrates (see above Figure tri-angled connection members that exhibit the same characteristics and limitations described above.

Claims 4-7 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Ulmer (US 4609183) in view of Savino (US 4236697) as applied to claim 1 and 9 above, and further in view of Cruwell, Jr. (US 5201426). Regarding claim 4, it is described above

what is disclosed by Ulmer in view of Savino; however the references do not disclose a third horizontal rail removably engaged and extending between a second set of vertical rails. Ulmer illustrates in Figures 2 and 3 a chain (CHR, CHL) that is removably engages and extending between the vertical rails. Cruwell illustrates in Figure 1 a rail (16) removably attached to the vertical rails (14 and 15). It would have been obvious to one having ordinary skill in the art at the time of invention to replace the chain (CHR) of Ulmer with the solid rail of Cruwell in order to have a rigid, more stable beam in place to keep a larger amount of carts from escaping the cart corral and damaging surrounding vehicles or people.

Regarding claims 5 and 12, Ulmer in view of Savino teaches means for attaching additional horizontal and vertical rails (16 of Savino) to said first and said second set of vertical rails comprising a quad-angled (or multi-angled) member (T-shaped member as shown in the above Figure) formed of polymerized sheathing (see above rationale) and having a hollow interior; wherein each leg of said quad-angled member extends simultaneously in planes to support said additional horizontal rail and vertical rails to said first and said second set of vertical rails; said interior having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said first and said second set of vertical rails. The examiner further notes that Savino illustrates (see above Figure tri-angled connection members that exhibit the same characteristics and limitations described above.

Regarding claim 6, Ulmer in view of Savino teaches separable means for attaching the horizontal rails to the vertical rails comprising a T-shaped member formed of polymerized sheathing and having a hollow interior; wherein each leg of said T-shaped member has an interior profile identical to the exterior profile of said horizontal rails and said vertical rails; said interior profile having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said horizontal rails and said vertical rails (See above Figure). Savino fails to disclose a specific material in which the member is made from; however Ulmer discloses all parts of the cart corral being made of steel covered with a colored plastic sheathing.

Regarding claim 7, Ulmer in view of Savino teaches means for separably attaching said horizontal rails to said vertical rails comprising an L-shaped member formed of polymerized sheathing and having a hollow interior; wherein each leg of said L-shaped member has an interior profile identical to the exterior profile of said horizontal rails and said vertical rails; said interior profile having a diameter equal to or greater than the exterior diameter of said polymerized sheathing surrounding each of said horizontal rails and said vertical rails. (See above Figure). Savino fails to disclose a specific material in which the member is made from; however Ulmer discloses all parts of the cart corral being made of steel covered with a colored plastic sheathing.

#### **(10) Response to Argument**

Regarding the applicant's argument:

"The Examiner argues that "a plastic coating certainly satisfies the limitation of a polymerized sheathing." (OA, near bottom of p. 3) Applicant respectfully disagrees. First, "sheathing" would be interpreted as a separate material used to cover something. The "coating" of Ulmer would not apply, as it is more like a coat of paint. Additionally, however, Applicant is claiming much more than "polymerized sheathing." Applicant is claiming "removable and replaceable polymerized sheathing," which the Ulmer reference clearly does not meet.

The examiner respectfully disagrees. Sheathing, by definition, is considered "a layer of material applied to the outer frame of a building to serve as a base for an exterior covering" or "an exterior protective covering." The plastic coating referred to by the examiner fits the definition of a polymerized sheathing. The polymerized portion of the limitation is met by the applicant's designation that the covering is plastic and the sheathing aspect, as one of ordinary skill in the art can see above, is an exterior protective covering. The coating protects, as described in the applicant's remarks and within the specification of the prior art, from rusting.

Regarding the applicant's argument:

"The use of the word "chip" makes it clear that Ulmer does not satisfy the limitation of removable and replaceable polymerized sheathing. Nor would a coat of plastic have a "diameter" according to Applicant's claims. A coating certainly

could not have a diameter "equal to or greater than the outer diameter of each [rail]."

The examiner respectfully disagrees with this assumption. First, the word "chip" certainly satisfies the limitation "removable." The very essence of something being chipped is that material is removed. Webster's defines "chip" as "a small piece cut or broken off," and to cut or break something is to remove it. The examiner further notes that since the plastic sheathing of the prior art is painted or coated on, if the sheathing were removed, it could certainly be painted or coated on again if necessary (which is would be to help inhibit rust from forming as stated within the prior art) - thus being replaceable.

In column 4, the prior art stated that the plastic coating is painted on. One of ordinary skill in the art would recognize that paint certainly has a thickness when applied to a surface. The coating, as numerous stated within the specification, is placed on the outside of the tubing or pipe. Therefore, since the paint or coating has a thickness in and of itself and is placed on the outside of the tubing, it would logically and inherently have an inner and outer diameter greater than that of the pipe or tubing.

Regarding the applicant's argument:

"Nor would it be obvious to use the connectors of Savino in the construction of Ulmer. Ulmer intentionally uses specialized rivets to facilitate maintenance and repair: "In addition, due to the modular construction, and the ease with which the

component parts may be disassembled as a result of the use of a specialized rivet, any damage to a side portion of the shopping cart corral permits repair of the corral by the replacement only of the damaged modular component or components, rather than a whole side section, as in the prior art constructions." (Ulmer; 3:18-25)"

The examiner again respectfully disagrees with the applicant's statement that it would not be obvious to combine the prior art references. The applicant has not supplied enough information as to why they do not think it is obvious to combine the references. The examiner believes that the applicant is trying to convey that it wouldn't be obvious to combine because the Ulmer reference is easily assembled and disassembled and the Savino reference is not. The examiner notes that the Savino reference teaches in column 2 that the preferred method of fastening the coupling elements to the piping is through threadably engaging the items. One of ordinary skill in the art would appreciate that threadably engaging items together is an easily reversible process. It would be easy for one of ordinary skill in the art, to quickly connect and disconnect the coupling elements from the pipes (as can be seen in Savino's illustrations, only the component that is damaged needs to be replaced given the connection structure). The examiner further notes that the scopes of both prior art references would not change with the combination. The scope of both prior art references is to provide an improved, durable, protective apparatus for shopping carts. Lastly, the examiner notes that KSR Int'l v Teleflex Inc. and MPEP 8, rev. 6, section 2143 states that simple substitution of one known element for another to obtain predictable results is obvious. The simple

substitution of the threadable connection piece of Savino in place of the rivet system of Ulmer would have been obvious because each yield the same predictable result of a stable securement that is easily engaged and disengaged.

Regarding the applicant's argument:

"First, it is apparent from the disclosures of Ulmer and Savino that they intend for carts to be pushed right through their corrals, on a first-in, first- out basis. Adding the third horizontal rail would defeat this intended purpose, defeating prima facie obviousness. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Second, there is no evidence whatsoever that the addition of this third horizontal rail would "keep a larger amount of carts from escaping the cart corral and damaging surrounding vehicles or people."

Considerations such as how users interact with the corral and the location of the corral (i.e, on flat ground, against a wall, etc.) are at least as important as the provision of additional rails."

The examiner disagrees with the applicant's arguments. First, Ulmer is the primary reference which would be modified by Cruwell, Jr. Ulmer discloses in column 3, lines 58-60 that Figure 2 illustrates the fully assembled cart corral embodying the present

invention. The chain (CHR) is in the "secured position" as defined by column 6 of Ulmer. This "secured position" means that carts are not able to enter or leave through that side of the cart corral. From the prior art Figure 2, one of ordinary skill in the art can see that only one "open position" is apparent and that only one way for a cart to enter and exit is possible for this configuration. The applicant is mistaken when he states that it is apparent that Ulmer intends "for carts to be pushed right through their corrals, on a first-in, first- out basis." This may be true in Figure 1, which is clearly labeled as a "prior art" Figure, but it is not true of the present invention embodiment Figure 2.

Second, a rigid metal bar as opposed to a fastened chain would be able to hold more weight back and keep carts from escaping into a surrounding parking lot. The chain can sway or be manipulated up or down by weather events or other outside forces (e.g. people, cars, etc.) which may allow enough space between it and surrounding rails for a cart to escape. However, a rigid rail which is secured in place cannot be easily manipulated, it would have to be ripped or broken off which would take considerable force. Therefore it is less likely for a cart to escape if a rigid rail is present as opposed to a fastened chain. The examiner also notes that KSR Int'l v Teleflex Inc. and MPEP 8, rev. 6, section 2143 states that simple substitution of one known element for another to obtain predictable results is obvious. The simple substitution of a rigid bar of Cruwell, Jr. in place of the chain of Ulmer would have been obvious because each yield the same predictable result of securing the carts within the corral and prohibiting the carts from escaping at one end.



**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark R. Wendell

Examiner, Art Unit 3635

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